

Serial No. 10/001,218  
Atty. Docket No. 49950-59824CON4

#### REMARKS

Claims 1-3 and 5-12, and 14-17 were pending in the instant application. Claims 2, 3, 5, 11, 12 and 14 have been canceled without prejudice or disclaimer, claims 1, 10 and 17 have been amended, and claims 19-22 have been added. Accordingly, claims 1, 6-10, 15-17 and 19-22 will be pending in the application upon entry of the instant Amendment.

Support for the amendments to claims 1, 10 and 17 and for the addition of claims 19-22 can be found throughout the specification and claims as originally filed. In particular, support can be found in the specification at least, for example, at page 8, lines 14-17, page 19, lines 1-14, and page 20, line 7 through page 21, line 16. No new matter has been added to the application by way of the amendments to the claims or the addition of claims.

Amendment and/or cancellation of the claims should in no way be construed as an acquiescence to any of the rejections set forth in the instant Office Action, and was done solely to expedite prosecution. Applicants reserve the right to pursue the claims as originally filed in this or one or more separate applications.

Applicants wish to thank Examiner Saidha for the helpful telephone interview with the undersigned on July 19, 2004.

#### *Claim Rejections - 35 U.S.C. §112, First Paragraph*

Claims 1-3, 6-12 and 15-17 are rejected under 35 U.S.C. §112, first paragraph, because the specification, although enabling for the recombinant strain of *Bacillus subtilis* YB886 (pLOH1500) transformed with *Z. mobilis* ADH and PDC genes, does not reasonably provide enablement for any eukaryotic cell or a method for ethanol production, including any animal cell, insect cell or fungal cell transformed with genes encoding ADH and PDC genes.

Applicants respectfully disagree. However, without acquiescing to the rejection and in order to expedite prosecution of the application, claims 1, 10 and 17 have been amended as set forth above. Applicants submit that claims 1, 10 and 17 as amended herein, and the claims depending therefrom, are fully enabled by the specification. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §112, first paragraph.

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***Non-Statutory Double Patenting***

Claims 1-3, 5-12 and 14-17 are rejected under the judicially created doctrine of double patenting over claims 1 and 2 of U.S. Patent 5,482,846. Likewise, claims 1-3, 5-12 and 14-17 are rejected under the judicially created doctrine of double patenting over claims 1 and 2 of U.S. Patent 5,916,787.


Applicants file concurrently herewith two terminal disclaimers directed to U.S. Patents 5,482,846 and 5,916,787, respectively. Applicants respectfully submit that the terminal disclaimers obviate the non-statutory double patenting rejection.

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### CONCLUSION

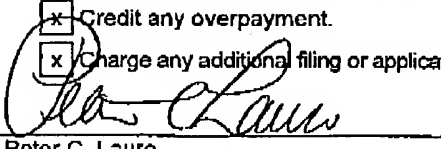
In view of the foregoing, entry of the amendments and remarks herein, reconsideration and withdrawal of all rejections, and allowance of the instant application with all pending claims are respectfully solicited. If a telephone conversation with Applicants' attorney would help expedite the prosecution of the above-identified application, the Examiner is urged to call Applicants' attorney at the telephone number below.

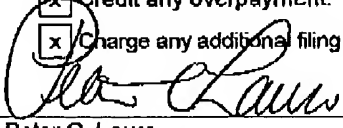
Respectfully submitted,  
EDWARDS & ANGELL, LLP

By 

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Date: July 20, 2004

<b>AMENDMENT TRANSMITTAL LETTER</b>			Docket No. 49950-59824CON4		
Application No. 10/001,218	Filing Date November 30, 2004	Examiner Saidha, T.	Art Unit 1652		
Applicant(s): Lonnie O. Ingram et al.					
Invention: ETHANOL PRODUCTION IN GRAM-POSITIVE MICROBES					
<b>TO THE COMMISSIONER FOR PATENTS</b>					
Transmitted herewith is an amendment in the above-identified application. The fee has been calculated and is transmitted as shown below.					
<b>CLAIMS AS AMENDED</b>					
	Claims Remaining After Amendment	Highest Number Previously Paid	Number Extra Claims Present	Rate	
<b>Total Claims</b>	13	- 20 =		x	0.00
<b>Independent Claims</b>	3	- 4 =		x	0.00
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					
Other fee (please specify):					
<b>TOTAL ADDITIONAL FEE FOR THIS AMENDMENT:</b>					0.00
<input type="checkbox"/> Large Entity <input checked="" type="checkbox"/> Small Entity					
<input checked="" type="checkbox"/> No additional fee is required for this amendment.					
<input type="checkbox"/> Please charge Deposit Account No. _____ in the amount of \$ _____. A duplicate copy of this sheet is enclosed.					
<input type="checkbox"/> A check in the amount of \$ _____ to cover the filing fee is enclosed.					
<input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.					
<input checked="" type="checkbox"/> The Director is hereby authorized to charge and credit Deposit Account No. <u>04-1105</u> as described below. A duplicate copy of this sheet is enclosed.					
<input checked="" type="checkbox"/> Credit any overpayment.					
<input checked="" type="checkbox"/> Charge any additional filing or application processing fees required under 37 CFR 1.16 and 1.17.					
 Peter C. Lauro Attorney Reg. No.: 32,360  EDWARDS & ANGELL, LLP P.O. Box 55874 Boston, Massachusetts 02205 (617) 439-4444			Dated: <u>July 20, 2004</u>		

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Other fee (please specify):					
<b>TOTAL ADDITIONAL FEE FOR THIS AMENDMENT:</b>					<b>0.00</b>
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